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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
: Examiner: Herbert J. Lilling  
TOMOHIRO SUZUKI, et al. )  
: Group Art Unit: 1651  
Application No.: 10/084,167 )  
:   
Filed: February 28, 2002 )  
:   
For: POLYHYDROXYALKANOATE )  
POLYESTER HAVING :  
VINYL PHENYL STRUCTURE )  
IN THE SIDE CHAIN AND :  
ITS PRODUCTION METHOD ) November 10, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Sir:

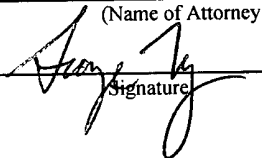
In response to the Restriction Requirement dated October 8, 2003,

Applicants hereby provisionally elect to prosecute the Group I claims, namely Claims 1, 3  
and 4. The Restriction Requirement is, however, traversed.

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first-class mail in an envelope addressed  
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1450 on

November 10, 2003  
(Date of Deposit)

George K. Ng (Reg. No. 54,334)  
(Name of Attorney for Applicant)

  
Signature

November 10, 2003  
Date of Signature

Traversal is on the ground that there would not be undue burden in examining the three groups of claims in a single application. In particular, MPEP § 808 makes clear that in order to require restriction between independent or distinct inventions, reasons for insisting upon a restriction requirement, such as undue burden, must also be shown. In the present instance, it is not believed that there would be an undue burden in examining the claims of Groups I, II and III in a single application, since the three groups of claims are not so different as would require a burden on the Examiner that is significantly beyond that of the normal burdens of examination.

In particular, there is absolutely no reason for restricting between the Group I product claims and the Group II product claims. The products of Group I and Group II are classified in the same class and subclass. Moreover, Claim 2, the sole claim of Group II, is dependent on Claim 1 of Group I. The Restriction Requirement mentioned (on page 5 thereof) that the inventions have “divergent subject matter” and different fields of search; but no evidence or patents were cited to support these allegations. Thus, the requirement to restrict between these two groups in particular is improvidently entered. See MPEP § 808.02:

“Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.”

In addition, given the close connection between the product claims of Groups I and II and the process claims of Group III, no reason is seen for insisting on restriction between Groups I and III and between Groups II and III. In any event, rejoinder is requested once the product of the Group I claims is found allowable.

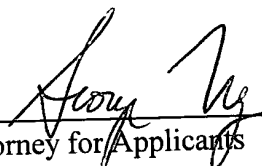
Accordingly, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

In response to the Election of Species Requirement, it is believed that such an election of species does not apply to the Group I claims.

Regarding a formal matter involving Information Disclosure Statements, Applicants note that two such Information Disclosure Statements have been filed to date. The first, dated June 12, 2002, was acknowledged in the Restriction Requirement. The second, dated August 19, 2003, was not. It is requested for the Examiner to consider the art cited in both.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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